

## REMARKS

Reconsideration of the above-identified application is respectfully requested.

Claim 2 is re-written in independent form.

Claims 1–4 have been rejected as anticipated by Giannopoulos et al. In support of the rejection, the Examiner asserts that the Giannopoulos et al. patent discloses "apparatus capable of" performing the claimed method.

1. If the Examiner's assertion were proper, then no ballast containing a microprocessor would be patentable. As such, the Examiner's position is contrary to the several Federal Circuit decisions holding that a programmed computer is a special purpose machine; e.g. *In re Alappat*, 31 USPQ2d 1545, at 1558 (Fed. Cir. 1994). Thus, one cannot properly ascribe just any function one wants to a microprocessor.

2. More specifically, the Examiner's position is directly contrary to the Federal Circuit's holding in *Crown Operations International Ltd. v. Solutia Inc.*, 62 USPQ2d 1917, at 1922 (Fed. Cir. 2002) [digest enclosed].

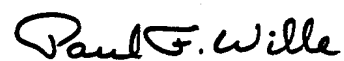
3. Whether or not the apparatus disclosed in the Giannopoulos et al. patent is "capable of performing" the claimed method is a matter of speculation. Rejections are supposed to be based on evidence, not on speculation.

4. The Giannopoulos et al. patent does not disclose peak detection. How can the patent anticipate when it does not disclose a recited element?

Claim 5 was rejected as unpatentable over Giannopoulos et al. in view of Alexandrov. The Alexandrov publication overcomes none of the deficiencies of the Giannopoulos et al. patent. Also, there is no basis, other than applicant's claims, for the combination; *In re Rouffet*, 47 USPQ2d 1453, at 1457 (Fed. Cir. 1998)

In view of the foregoing amendment and remarks, it is respectfully submitted that claims 1-5 are in condition for allowance and a Notice to that effect is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink that reads "Paul F. Wille". The signature is written in a cursive, slightly stylized font.

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*Crown Operations International Ltd. v. Solutia Inc.*

62 USPQ2d 1917, 1922 (Fed. Cir. 2002)

[1] Regarding alleged anticipation by the Gillery patent, on its face the Gillery patent does not disclose or discuss a two percent limitation for the reflectance contribution of the solar control film. Crown maintains that the '511 patent merely claims a preexisting property inherent in the structure disclosed in the prior art. Crown urges us to accept the proposition that if a prior art reference discloses the same structure as claimed by a patent, the resulting property, in this case, two percent solar control film reflectance, should be assumed. We decline to adopt this approach because this proposition is not in accordance with our cases on inherency. If the two percent reflectance limitation is inherently

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disclosed by the Gillery patent, it must be necessarily present and a person of ordinary skill in the art would recognize its presence. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); *Continental Can*, 948 F.2d at 1268, 20 USPQ2d at 1749. Inherency “may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* at 1269, 20 USPQ2d at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)).